

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. **020431.0755**

In re Application of:

JOACHIM P. WALSER, ET AL.

Serial No. **09/896,388**

Filed: **28 JUNE 2001**

For: **GENERATING AN OPTIMIZED PRICE
SCHEDULE FOR A PRODUCT**

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Examiner:

CRISTINA O. SHERR

Art Unit: **3621**

Confirmation No.: **1011**

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

This response is submitted in response to the Restriction Requirement mailed 7 December 2007, which provides for a one-month response period ending 7 January 2008. Please consider the following election and remarks.

TELEPHONIC INTERVIEW WITH EXAMINER:

Initially, the Applicants respectfully note that the undersigned, Steven J. Laureanti conducted a telephone conference with Examiner Cristina O. Sherr on 10 December 2007 to clarify the Restriction Requirement mailed 7 December 2007. Specifically, Mr. Laureanti requested clarification as to Examiner Sherr's statement in the Restriction Requirement mailed 7 December 2007, which stated:

A telephone call was made to Steven J. Laureanti, reg. no. 50,274 on or about November 27, 2007 to request an oral election to the above restriction requirement, but did not result in an election being made.

Mr. Laureanti asserted that he did not have any records of an alleged telephone call on or about 27 November 2007, as stated by the Examiner in the Restriction Requirement mailed 7 December 2007. In response, Examiner Sherr stated that she merely telephoned Mr. Laureanti and when no one answered, Examiner Sherr hung-up. Examiner Sherr further stated that she did not leave a message or speak with Mr. Laureanti or anyone regarding the alleged request for an oral election to the Restriction Requirement.

Mr. Laureanti further requested clarification as to why Examiner Sherr would just hang-up, not leave a message, and then assert the above statement in the Restriction Requirement mailed 7 December 2007. Examiner Sherr stated that she had a deadline and could not leave a message, but had to mail-out an Office Action, in order to meet the deadline. The Applicants thank Examiner Sherr for her honesty, in the telephone conference on 10 December 2007, but respectfully submit that the Examiner did not follow the MPEP 812.01, regarding Telephone Restriction Practice.

The Applicants respectfully direct the Examiner's attention to MPEP 812.01:

If an examiner determines that a requirement for restriction should be made in an application, the examiner should formulate a draft of such restriction requirement including an indication of those claims considered to be linking or generic. ** Thereupon, ***the examiner should telephone the attorney*** or agent of record ***and request an oral election***, with or without traverse **, ***after the attorney or agent has had time to consider the***

restriction requirement. However, no telephone communication need be made where the requirement for restriction is complex, the application is being prosecuted by the applicant pro se, or the examiner knows from past experience that an election will not be made by telephone. **The examiner should arrange for a second telephone call within a reasonable time,** generally within 3 working days. If the attorney or agent objects to making an oral election, or fails to respond, **a restriction letter will be mailed, and this letter should contain reference to the unsuccessful telephone call.** When an oral election is made, the examiner will then proceed to incorporate into the Office action a formal restriction requirement including the date of the election, the attorney's or agent's name, and a complete record of the telephone interview, followed by a complete action on the elected **invention as claimed,** including linking or generic claims if present. (Emphasis Added).

In addition, the Applicants respectfully direct the Examiner's attention to form paragraph 8.23.02, which the MPEP clearly states should be used to make a telephone election of record:

¶ 8.23.01 Requirement, No Election by Telephone

A telephone call was made to [1] on [2] to request an oral election to the above restriction requirement, but did not result in an election being made.

Examiner Note:

1. In bracket 1, insert the name of the applicant or attorney or agent contacted.
2. In bracket 2, insert the date(s) of the telephone contact(s).
3. This form paragraph should be used in all instances where a telephone election was attempted and the applicant's representative did not or would not make an election.
4. ***This form paragraph should not be used if no contact was made with applicant or applicant's representative.***

(Emphasis Added). It appears that in the Restriction Requirement mailed 7 December 2007, the Examiner used form paragraph 8.23.01. However, the Applicants note that the MPEP clearly states that ***"[t]his form paragraph should not be used if no contact was made with applicant or applicant's representative"***. The Applicants respectfully submit that as acknowledged by the Examiner, in the telephone conference on 10 December 2007, that no contact was made with the Applicants representative, Mr. Laureanti, and that as such, it was inappropriate for the Examiner to use form paragraph 8.23.01.

In addition, during the telephone conference with Examiner Sherr on 10 December 2007, Mr. Laureanti further respectfully requested clarification as to distinctions between the alleged patentably distinct species. Specifically, Mr. Laureanti requested an explanation as to why the alleged species are allegedly independent or distinct. Mr. Laureanti further requests that the Examiner group the claims in accordance with the Examiner's alleged patentably distinct species. In response, Examiner Sherr stated that she will not examine claims for identification of species in the claims, but instead merely stated that the specification contains three patentably distinct species.

The Applicants respectfully submit that the Examiner has not established the Examiner's burden with respect to MPEP 808.02 and 809.02(a). Specifically, the ***Examiner fails to clearly identify each of the disclosed species, the claims are not grouped in accordance with the species to which they are to be restricted, and the Examiner has not provided any reasons why the species are independent or distinct.*** (See 809.02(a)). In addition, it is respectfully noted, that ***Examiner Sherr has already examined Applicants claims in at least the Office Actions dated: 4 June 2007; 18 December 2006; and 2 June 2006.*** Therefore, because the Examiner has already examined Applicants claims and has failed to state any reasons for now insisting upon a restriction, ***there simply cannot be a serious burden, let alone any burden, on the Examiner if restriction is not required.***

The ***Applicants respectfully submit that the Restriction Requirement is improper.*** Accordingly, in traverse, ***Applicants request withdrawal of the Restriction Requirement.*** The Examiner is invited to contact the undersigned, Steven J. Laureanti, at (480) 830-2700 with any questions, comments, or suggestions relating to the subject Application.

ELECTION WITH TRAVERSE:

The Restriction Requirement alleges the subject Application contains claims directed to the following patentably distinct species:

- A. The embodiment in which constraints are placed on successor states, as in page 10, ln 9-17 of the specification.
- B. The embodiment in which constraints are placed on price changes, as in page 10, ln 18-25 of the specification.
- C. The embodiment in which constraints are placed on inventory values, as in page 10 ln 25-36 of the specification.

Because the Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits, the Applicants direct the Examiner's attention to the following species:

- 1a. Species of Claims 1, 4, 5, 7, 9, 12, 13, 15, 17, 20, 21, 23, 25;
- 1b. Species of Claims 1, 3, 9, 11, 17, 19, 25; and
- 1c. Species of Claims 1, 2, 8, 9, 10, 16, 17, 18, 22, 24, and 25.

The Applicants elect, with traverse, to pursue Claims 1, 4, 5, 7, 9, 12, 13, 15, 17, 20, 21, 23, 25 which are directed to a single species (i.e., species 1a). The Applicants respectfully submit that Claims 1, 9, 17, and 25 are considered generic claims. The Applicants reiterate that the foregoing election is not an acquiescence in the propriety of the restriction or in the accuracy in the determination and/or identification of the alleged "species" in the subject Application. The Applicants respectfully request withdrawal of the Restriction Requirement as set herein, because the Requirement is clearly improper.